

REMARKS

In the Final Office Action mailed July 31, 2003, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite because “the term ‘non-persistent communication channel’ is not clearly defined,” and for insufficient antecedent basis of the term “the user;” rejected claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,564,261 to Gudjonsson et al. (“Gudjonsson”); and rejected claim 17 under 35 U.S.C. § 103(a) as being obvious over Gudjonsson in view of U.S. Patent No. 6,584,122 to Matthews et al. (“Matthews”).

In the Advisory Action mailed January 2, 2004, the Examiner withdrew the rejections under 35 U.S.C. § 112, but maintained the remaining rejections.

Summary of this Response

By this amendment, Applicants have amended claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 17 to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention. In light of the following remarks, Applicants respectfully request the timely reconsideration and allowance of the present application.

Detailed Response

Claim Amendments

By this Amendment, Applicants have amended claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 17 to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants submit that no new matter is introduced by these amendments as the amendments are adequately supported by the specification, including, but not limited to paragraph 20 on pages 5-6.

Rejections under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejections of claims 1-16 as being unpatentable under 35 U.S.C. § 102(e), since the cited reference does not teach each and every element of the claim in issue, either expressly or under principles of inherency, as required by 35 U.S.C. §102(e). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” See M.P.E.P. § 2131(8th Ed. Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th Ed. 2001). Applicants submit that these requirements have not been met for at least the following reasons.

Independent claim 1 recites a combination including, for example, “configuring one or more rules for responding to a communication attempt to the at least one communication device based on information in the message.” Gudjonsson teaches a “system/ network [that] acts as a broker(s), and can broker communication service between two or more people.” See Col. 7, lines 53-54. It accomplishes this by allowing a user to send an invitation, which “is basically a request from one user 7 to another the join him/ her in some given type of communication.” See Col. 9, lines 8-10. While Gudjonsson does provide a “routing service, that allows users to send requests (i.e., invitations for communication sessions to other users, as well as configure how these invitations are handled,” it does not disclose “configuring one or more rules for responding to a communication attempt,” as recited in claim 1. Accordingly, configuring how that invitation is sent cannot constitute “configuring one or more rules for responding to a communication attempt,” as recited in claim 1. Accordingly, Applicants respectfully request the allowance of claim 1. By virtue of their dependence from claim 1, claims 2-4 are also allowable.

For the same reason, Gudjonsson fails to teach at least “configuring one or more rules for responding to a communication attempt to the at least one communication device based on information in the message,” as recited in claim 5, and “means for configuring one or more rules for responding to a communication attempt to the at least one communication device based on information in the message,” as recited in claim 9. Furthermore, by virtue of their dependence from claims 5, and 9, dependent claims 6-8, and 10-12 are also allowable.

Independent claim 13 recites a combination including, for example, “means for configuring a connection for establishing the telephone calls to the user in accordance with the rules, including forwarding calls when necessary to one or more terminals associated with the user.” The Examiner has asserted that this claim is anticipated by Gudjonsson. More specifically, the Examiner asserted that forwarding an invitation constitutes “forwarding calls when necessary to one or more terminals,” as claimed. O.A. at pp. 4-5. Applicants disagree. An invitation is nothing more than “a request from one user 7 to another to join him/her in some given type of communication.” Col. 9, lines 8-10. Applicants respectfully submit that an invitation is not a telephone call, and therefore, forwarding a call is not the same as forwarding an invitation. Applicants, therefore, respectfully request the allowance of claim 13, and by virtue of their dependence from claim 13, claims 14-16 as well.

Rejections under 35 U.S.C. § 103(a)

The rejection of claim 17 as unpatentable under 35 U.S.C. § 103(a) is respectfully traversed, since the Examiner has not made a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” (See M.P.E.P. § 2143 (8th Ed. 2001)). Applicants submit that these requirements have not been met for at least the following reasons.

The Examiner rejected claim 17 under 35 U.S.C. § 103(a) over Gudjonsson in view of Matthews. Applicants respectfully traverse this rejection for at least the following reasons.

First and foremost, Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness, because the Examiner has failed to allege any suggestion for combining Gudjonsson with the speech processor of Matthews. In the Office Action, the Examiner merely stated that “[i]t would have been obvious to one skilled in the art at the time the invention was made to modify Gudjonsson et al to have the “receiving a ... speech processor,” as taught by Matthews et al such that the modified system of Gudjonsson al [sic] would be able to support the speech processor to the system users.” See O.A. at pp. 5-6. Applicants submit that this rejection amounts to no more than a conclusory assertion that the combination is obvious, without any identified motivation, absent that in Applicants’ own disclosure, to motivate such a combination. Accordingly, Applicants submit that this falls far short of a *prima facie* case for obviousness.

Moreover, even if the combination suggested by the Examiner were made, such combination neither teaches nor suggests combined elements including, “configuring one or more rules for responding to a communication attempt at the at least one communication device based on the information in the call,” as recited in claim 17. As discussed above, with regard to

claim 1, Gudjonsson does not teach or suggest this element. Furthermore, Matthews fails to cure this deficiency, because, it too fails to teach or suggest such an element. Accordingly, no combination of Gudjonsson and Matthews can render claim 17 obvious, and Applicants, therefore, request its timely allowance.

Conclusion

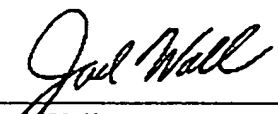
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of pending claims 1-17.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 07-2347.

Respectfully submitted,

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Dated: January 30, 2004

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